UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,369	04/05/2001	Wolfgang Schulz	SCHULZ 2	4003

1444 7590 03/31/2003

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER
PRATT, CHRISTOPHER C

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 03/31/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/826,369	WOLFGANG SCHULZ	
	Examiner	Art Unit	
	Christopher C Pratt	1771	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *7-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-6 and 11, drawn to a fabric, classified in class 442, subclass 59+.

   II. Claims 7-10, drawn to a method for producing a fabric, classified in class 8, subclass various.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another process comprising utilizing a nonwoven fabric.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Sheridan Neimark on 3/20/03 a provisional election was made with traverse to prosecute the invention of group I, claims 1-6 and 11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

DETAILED ACTION

Claim Objections

5. Claim 1 is objected to because of the following informalities: Please replace the phrase "wherein it is made from" with "comprising" or "consisting," as appropriate. Correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because of the phrase "(PES)." What does "PES" stand for? The use of the parenthesis makes it uncertain if this limitation is part of the claimed subject matter. Slimily, it is uncertain if the limitation "(continuous filament yarn)" is part of the claim.

Claim 1 is also indefinite because the phrases "filament yarn" and "monofilament yarn" are oxymorons. Yarn is a term recognized in the art as referring to a combination of multiple threads. Is applicant attempting to claim a monofilament thread or a yarn composed of multiple monofilaments.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since

the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 3 and 11 recite the broad recitation "wet-dyed" and "an awning," and the claim also recites "particularly..." which is the narrower statement of the limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Geisel (5674437).

Geisel is concerned with the creation of an awning fabric (col. 5, line 14) comprising polyester monofilaments (col. 3, lines 22-23 and 29-30).

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao et al (5747392).

Xiao is concerned with the creation of an awning fabric (col. 4, line 5) comprising continuous polyester fibers (col. 4, lines 20-25).

Xiao teaches UV block (col. 14, lines 5-7).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Geisel (5674437).

Geisel teaches the use of fibers but fails to specifically mention the cross sectional shape. If these fibers were not inherently round then it would have been obvious to utilize round fibers. Such a modification would have been motivated by the desire to utilize the most commonly commercially available fibers.

12. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Xiao et al (5747392).

Xiao teaches the use of fibers but fails to specifically mention the cross sectional shape. If these fibers were not inherently round then it would have been obvious to

utilize round fibers. Such a modification would have been motivated by the desire to utilize the most commonly commercially available fibers.

13. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al (5747392).

Xiao teaches the fabric to have a basis weight of 278 g/sm (col. 15, lines 65-67). It would have been obvious to a person having ordinary skill in the art to slightly reduce the weight of the fabric. Such a modification would have been motivated by the desire to utilize a lighter fabric.

With respect to claim 11, it would have been obvious to configure the awning fabric to have arms. Such a modification would have been motivated by the desire to render the awning more commercially successful.

14. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao et al (5747392) in view of Reinert et al (5914444).

Reinert is concerned with the creation of an awning fabric (col. 1, line 20) comprising polyester fibers (col. 21, line 64). Reinert teaches applying a combination of anthraquinone-based dye (col. 2, line 25) and triazine based UV block (col. 11, lines 21-23). It would have been obvious to apply this combination to the fabric of Xiao. Such a combination would have been motivated by the desire to impart color to the fabric while providing improved sun protection.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher C. Pratt
March 24, 2003